REMARKS

No claims are amended. No new claims are added. Claims 1-70 are pending for consideration. In view of the following remarks, Applicant respectfully requests reconsideration and allowance of the subject application.

CLAIM REJECTIONS

35 U.S.C. § 103

Claims 1-5 and 9-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,999,932 to Paul in view of Applicant Admitted Prior Art (AAPA), U.S. Patent No. 6,199,102 to Cobb, and U.S. Patent No. 6,704,772 to Ahmed et al (hereinafter "Ahmed").

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Paul in view of AAPA, Cobb, Ahmed, and U.S. Patent No. 5,459,717 to Mullan.

Claims 7-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Paul in view of AAPA, Cobb, Ahmed, and U.S. Patent No. 6,072,942 to Stockwell.

Claims 12-15, 17, 24-27, 29, 30, 32-37, 38, 40, and 41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cobb in view of AAPA, Ahmed, Stockwell '942, and U.S. Patent No. 6,199,103 to Sakaguchi et al (hereinafter "Sakaguchi").

Claims 16 and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cobb in view of AAPA, Ahmed, Stockwell '942, Sakaguchi, and Mullan.

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Claims 18, 28, and 39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cobb in view of AAPA, Ahmed, Stockwell '942, Sakaguchi, and Paul.

Claims 19-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sakaguchi in view of AAPA, Ahmed, and Stockwell '942.

Claim 23 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Sakaguchi in view of AAPA, Ahmed, Stockwell '942, and Mullan.

Claim 42 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Cobb in view of AAPA, Ahmed, and Sakaguchi.

Claims 43-45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cobb in view of AAPA, Paul, Sakaguchi, and U.S. Patent No. 6,144,934 to Stockwell.

Claim 46 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Cobb in view of AAPA, Paul, Sakaguchi, Stockwell '934, and Mullan.

Claim 47 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Cobb in view of AAPA, Paul, Sakaguchi, Stockwell '934, and Stockwell '942.

Claims 48 and 52 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Paul in view of Ahmed and AAPA.

Claim 49 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Paul in view of Ahmed, AAPA, and Stockwell '942.

Claim 50 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Paul in view of Ahmed, AAPA, and Cobb.

Claim 51 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Paul in view of Ahmed, AAPA, and Mullan.

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Claims 53-57 and 61-63 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Paul in view of Ahmed and Cobb.

Claim 58 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Paul in view of Ahmed, Cobb and Mullan.

Claims 59 and 60 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Paul in view of Ahmed, Cobb, and Stockwell '942.

Claims 64-67 and 69 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cobb in view of Ahmed, Stockwell '942, and Sakaguchi.

Claim 68 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Cobb in view of Ahmed, Stockwell '942, Sakaguchi, and Mullan.

Claim 70 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Cobb in view of Ahmed, Stockwell '942, Sakaguchi, and Paul.

Claims 1-42 and 48-70

According to § 103(c) [emphasis added]:

> Subject matter developed by another person, which qualifies as prior art ***only under*** one or more of ***subsections (e)***, (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, ***owned by the same person or subject to an obligation of assignment to the same person***.

Ahmed, used in the rejection of claims 1-42 and 48-70, qualifies as prior art only under subsection (e) of § 102. Section 102(e) states:

> A person shall be entitled to a patent unless . . . (e) the invention was described in . . . (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent. . . .

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The present application was filed on February 4, 2000. The Ahmed application was filed on September 20, 1999, which is before the filing of the present application. Furthermore, Ahmed does not qualify as 102(b) prior art because it did not issue more than one year before the filing date of the present application – rather, it issued ***after*** the filing date of the present application.

The rights to both the Ahmed patent and the present application were owned by Microsoft Corporation as of the respective filing dates. MPEP § 706.02(l)(2) states that common ownership can be established if the application files refer to assignments which are recorded in the PTO, as long as the assignments conveyed the entire rights in the applications to the same person or organization. Applicant submits that the application files for each of these references, the present application and the Ahmed patent, refer to assignments that are recorded in the PTO.

MPEP § 706.02(l)(1) specifies that "[t]his change to 35 U.S.C. 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999. . . ." Because the present application was filed on February 4, 2000, the change to 35 U.S.C. § 103(c) applies to the present application.

Accordingly, Ahmed cannot be cited as prior art in a valid § 103 rejection. Since rejections for all the above-listed claims rely on Ahmed, it is respectfully submitted that the rejections are no longer valid. Accordingly, it is requested that these rejections be withdrawn, and that all above-listed claims be allowed.

Claims 43-47

Claim 43 recites an email screening method comprising [emphasis added]:

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- ***defining an index having values that are assigned to various degrees of desirability*** that an email message can have, wherein the degrees of desirability extend from a low degree of desirability to a high degree of desirability;
- associating a plurality of parameters having parameter values with the various degrees of desirability, wherein at least some of the parameters do not depend on any message that is conveyed by any content of an email message;
- establishing a user interface through which a user can adjust either (a) individual parameter values that, in turn, establish a degree of desirability, or (b) index values that themselves establish a degree of desirability that email messages must have in order to be saved to dedicated user storage locations; and
- evaluating, using a computing device comprising part of an email system in which, for at least some users of the system, a client user interface email environment is generated through use of HTML or web pages that are sent to client devices, incoming email messages against the index value that is defined by the user.

In making out the rejection of this claim, the Office states that Cobb in view of AAPA and Paul does not teach evaluating incoming email messages against the index value that is defined by the user. Applicant agrees. The Office then argues that Sakaguchi teaches the following:

- defining an index having values that are assigned to various degrees of desirability that an email message can have, wherein the degrees of desirability extend from a low degree of desirability to a high degree of desirability;
- establishing a user interface through which a user can adjust either (a) individual parameters that, in turn, establish a degree of desirability, that email messages must have in order to be saved; and

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- evaluating incoming email messages against the index value that is defined by the user.

The Office cites to column 6, lines 28-29, and column 6, line 56, through column 7, line 5, to support its argument. Those excerpts are reproduced below:

> The user can also see the data stored in the estimated junk electronic mail storage section 6 . . . . *Col. 6, lines 28-29.*
>
> This process is repeated for all the junk electronic mail determination conditions and the total value is adopted as the junk degree of the electronic mail being evaluated at step ST2.
>
> Whether or not the found junk degree exceeds a preset threshold value is determined at step ST3. If the junk degree does not exceed the threshold value, the similarity to the determination conditions prepared based on junk electronic mail is low and thus the possibility that the electronic mail may be non-junk electronic mail is high. Then, the electronic mail is determined estimated non-junk electronic mail at step ST4. On the other hand, if the junk degee exceeds the threshold value, the similarity to the determination conditions prepared based on junk electronic mail is high and thus the possibility that the electronic mail may be junk is high. Then, the electronic mail is determined estimated junk electronic mail at step ST5. *Col. 6, line 56, through col. 7, line 5.*

Applicant maintains its position as articulated in the response to the previous Office Action dated January 30, 2004. This position is reproduced below for the Office's convenience [emphasis in original]:

> Applicant respectfully but strongly disagrees with the Office's argument and traverses the Office's rejection. Sakaguchi does not disclose defining an index, as Applicant has defined and used that term in its specification. In order to aid the Office's understanding of the claimed subject matter, the Office is respectfully referred to page 17, line 12, through page 19, line 4, of the specification. That excerpt is set forth below [emphasis added]:

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Desirability Index

In one embodiment, the concept of a desirability index is used to assess email messages. Fig. 7 shows one such exemplary index at 300. ***The idea behind the desirability index is that index values, here 1-7, are assigned to various degrees of desirability that an email message can have.*** The degrees of desirability range from a low desirability value of 1 to a high desirability value of 7. ***The index values are associated with a plurality of parameters having parameter values.*** For exemplary purposes only, Table 2 sets forth the index values that are cross-referenced against some example parameters.

Index Values	Number of specified recipient addresses	Percentage of invalid specified recipient addresses	Larger than X bytes	Delivery time
1	>1000	>20%	>X	Between 11:30 P.M and 3:30 A.M.
2	0 < y <= 200	>10%	>X	Between 10:00 P.M. and 12:00 P.M.
3	0 < y <= 150	5-15%	>X	Daytime
4	0 < y <= 100	5-10%	<X	Daytime
5	<=30	0-10%	<X	Daytime
6	<=20	0-5%	<X	Daytime
7	<=20	0-3%	<X	Daytime

The parameters in this example include: the number of specified recipient addresses, the percentage of invalid specified recipient addresses, a size parameter, and a delivery time parameter. ***The parameters each have values that correspond to the various index values.*** Some of the parameters do not depend on any message conveyed by any content of an email message. The parameter values are preferably adjustable so that different patterns of delivery can be examined.

Fig. 8 shows a user interface 302 that can be used in connection with desirability index 300. The user interface 302 is established so that a user, client, or recipient can adjust either or both of the individual parameter values or the index values. ***If the user adjusts a parameter value, then the index value associated with a certain degree of desirability is made either more or less restrictive. If the user adjusts the index value, then the user changes the degree of desirability.*** The

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> email server then uses the ***selected index value*** to assess and evaluate incoming email messages for the user.
>
> For example, when an email message is received at the server location, a score can be calculated based upon one or more of the parameters. Any number or combination of parameters can be used. In addition, parameters other than those specifically shown can be used. ***The score is then compared with an index value that is selected by a user or recipient. In this manner, the user-selected index value represents a threshold value.*** The index or threshold value defines a likelihood that a particular email message will constitute an unwanted email message. If an email message's score exceeds the threshold value (here, in the negative direction), then the email message likely constitutes one that a user or recipient does not want. If this is the case, the server can then place a copy of the email message at storage location 44 (Fig. 5) and send notifications to the intended recipients.

As shown above, particularly in Table 2, Applicant's index value is an ***abstraction*** of a group of one or more parameters. For a given piece of email, a score can be calculated based upon the one or more parameters. Both parameter values and index values can be adjusted by the user. The score is then compared with the ***index value*** that is selected by a user or recipient to determine whether the email likely constitutes an unwanted message.

In contrast, Sakaguchi's system generates a junk degree based upon extracted keywords. If the junk degree exceeds a pre-set threshold, the mail is determined estimated junk electronic mail. Applicant respectfully submits that Sakaguchi does not teach or suggest defining an index, as that term is defined and used by Applicant. Rather, Sakaguchi's system is based upon a single ***parameter***. Applicant's Table 2 contains several examples of parameters. For example, if the number of specified recipient addresses of a particular email is 25, the associated index value would be 5. In Applicant's system, incoming email messages are evaluated against the ***index value*** defined by the user. Therefore, if the user selects an index value of 6 as a threshold, the email likely constitutes unwanted email because index value 5 is less than selected index value 6. However, if the user selects an index value of 4, the email likely does not constitute unwanted email because index value 5 is greater than selected index value 4. If Sakaguchi were to use the same parameter (which it does not), it would compare the parameter value of 25 with the threshold value of 30. Sakaguchi's system would then

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immediately label the email as estimated junk electronic mail or estimated nonjunk electronic mail with no further abstraction from parameter value to index value.

Accordingly, for at least this reason, this claim is allowable.

In the current Office Action, the Office restates its previous rejection of this claim without responding substantively to Applicant's argument. Applicant is doing its best to further prosecution of this application but can do nothing more than repeat its original argument until it receives a substantive response to that argument. Applicant respectfully requests the Office to either withdraw this rejection or to respond to Applicant's argument.

Claims 44-47 depend from claim 43 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 43, are neither shown nor suggested by the references as cited and applied by the Office. In addition, given the Office's failure to establish a *prima facie* case of obviousness, the rejection of claims 46 and 47 over Mullan and Stockwell '942, respectively, is not seen to add anything of significance.

Conclusion

Applicant respectfully submits that all pending claims are in condition for allowance. Accordingly, Applicant requests that a Notice of Allowability be issued. If the Office's next anticipated action is to be anything other than issuance of a Notice of Allowability, Applicant requests that the undersigned be contacted for the purpose of scheduling an interview.

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Respectfully submitted,

Dated: 10/07/04

By: RR Cottle

Rob R. Cottle.
Reg. No. 52,772
(509) 324-9256 ext. 247

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